Remarks

The Applicants submit the present response within two months of the date of mailing of the Final Office Action and request an Advisory Action. The Examiner cites new grounds for rejection of the pending claim in the Final Office Action stating that the Applicants' amendments necessitate the new grounds. However, the claims were merely amended to address the Examiner's earlier rejections under 35 U.S.C. §112 and the new grounds for rejection of the pending claims under 35 U.S.C. §102(e) is essentially identical to the grounds for rejection of the cancelled claims, e.g. U.S. Patent No. 6,263,447). Aside from the amendments made to the pending claims to address the Examiner's rejection under 35 U.S.C. §112 and place many of the pending claims in independent form to include the limitations of the claims from which they previously depended, the limitations of the claims were clearly set out in those claims as originally presented. In fact, the amendments made in response to the 35 U.S.C. §112 rejection were the amendments suggested by the Examiner. See ¶3 of the office action dated March 24, 2005.

As stated at MPEP 706.07, "the invention as disclosed and claimed should be thoroughly searched in the first action and the reference fully applied." The limitations of the pending claims having been presented in the application as originally filed, the reference relied upon could have been applied to these claims in the first office action, but were not. MPEP 706.07(a) states that a second office action shall be final "except where the examiner introduces a new ground of rejection that is [not] necessitated by applicant's amendment of the claims". The amendments made were essentially those suggested by the Examiner. Here, the Applicants' amendments did not necessitate the new grounds for rejection and the Final Rejection is improper.

Further, the MPEP states that the "applicant who is seeking to define his or her invention in claims that will give him or her the patent protection to which he or she is justly entitled should receive the cooperation of the examiner to that end , and not be prematurely cut off in the prosecution of his or her application." MPEP 706.07. Further, "a clear issue between applicant and examiner should be developed, if possible, before appeal." *Id.* Here, because the Examiner failed to raise the present rejection under 35 U.S.C. §102(e) in the first office action, the Applicants have not yet been afforded the opportunity to fully develop this issue for appeal.

The Examiner is requested to withdraw the final rejection, enter the present response into the record, and consider the following arguments of the Applicants.

Claims 10, 12, 13, 14, 33, 35, 36, 37, 52, 56 and 73 are pending. Claims 52 and 56 stand rejected under 35 U.S.C. §101. Claims 10, 12, 13, 14, 33, 35, 36, 37, 52, 56 and 73 stand rejected under 35 U.S.C. §102(e). Applicants traverse the rejections.

Claims 52 and 56 are statutory subject matter.

Applicants traverse the Examiner's rejections of claims 52 and 56 on the basis of 35 U.S.C. §101 as improper. It is well established that when functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory. See MPEP §2106(IV)(B)(1). Functional descriptive material consists of data structures and computer programs which impart functionality when employed as a computer component. *Id.* Nonfunctional descriptive matter includes such material as music, literary works or a compilation or mere arrangement of data. *Id.* Here, the rejected claims claim a computer readable medium having functional descriptive material defining the functions in a computer for determining a level of trust in an authenticated identification.

The Federal Circuit is also very clear on this point. Computer programs embodied in a tangible medium are patentable subject matter under 35 U.S.C. §101. *In re Beauregard*, 53 F.3d 1583, 35 USPQ2d 1383 (fed. Cir. 1995). See also *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994) (claim to data structure stored on a computer readable medium than increases computer efficiency held statutory) and *In re Warmerdam*, 33 F.3d 1354, 1360-61, 31 USPQ2d 1754, 1759 (Fed. Cir. 1994) (claim to computer having a specific data structure stored in memory held statutory product-by-process claim).

Applicants respectfully submit that claims 52 and 56 represent functional descriptive material that is recorded on a computer-readable medium and, therefore, represent statutory subject matter. Withdrawal of the rejection is requested.

The Examiner has failed to show how the reference relied upon teaches the present invention as set forth in Claims 10, 12, 13, 14, 33, 35, 36, 37, 52, 56 and 73.

The Examiner has failed to show how each and every element of the pending claims is taught in the '447 reference.

With regard to claims 10, 33 and 56, the claims are directed toward allowing a first level of access to a resource if the determined level of trust exceeds a first predetermined threshold and allowing a second level of access to a resource if the determined level of trust

exceeds a second predetermined threshold. The '447 reference does not appear to teach the invention as claimed. The resources mentioned at column 6, lines 10-13 of the '447 patent merely discuss "resources 140 which are accessible to the application server 130." The '447 patent appears to teach a system and method directed at performing multiple levels of authentication using different types of information. See col. 2, lines 12-18; col. 3, lines 16-45; and col. 16, lines 41-64. Claims 10, 33 and 56, in contrast, combine the scores for successful authentications to determine a level of trust, which is used to allow first and second levels of access to a resource response to the determined level of trust exceeding a first and second predetermined threshold, respectively. The Examiner has failed to show how the '447 reference teaches the invention as set forth in claims 10, 33 and 56.

With regard to claims 12 and 35, the claims are directed toward allowing a requested action to proceed if the determined level of trust exceeds a predetermined minimum level of trust associated with the requested action. The Examiner appears to allude to Figure 30 of the '447 patent as teaching this feature of these claims. However, the '447 patent appears to teach a process for determining a next action to take in the authentication process, rather than allowing a requested action. "The authenticity certainty score may be employed and compared against predetermined thresholds to determine the next action for the request (i.e., approve, approve with restrictions, deny, go to fir or other level preprocessing)." Col. 12, lines 25-29. See also col. 14, lines 25-40, and col. 15, lines 33-53. The table of Figure 30 appears to be a threshold table for generating responses. Col. 15, lines 51-53. The reference relied upon appears to teach a process for determining which action, e.g. response, to be taken next in the authentication process rather than the invention set forth in claims 12 and 35, which allows a requested action based on the determined level of trust. The Examiner has failed to show how the '447 reference teaches the invention as set forth in claims 12 and 35.

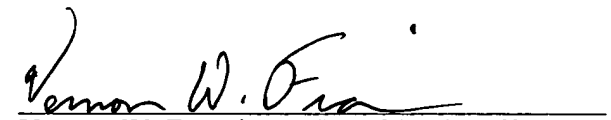
With regard to claim 13 and 36, the claims are directed toward presenting a list of allowable action having minimum trust levels no exceeding the determined level of trust. Claims 14 and 37, which depend from claims 13 and 36, respectively, are directed toward receiving input specifying one of the present actions and initiating the specified action. As noted above, the '447 patent appears to teach a process for determining a next action to take in the authentication process, rather than presenting a list of allowed actions not exceeding the determined level of trust. Nor does the '447 patent appear to teach receiving input specifying an action from the presented list and initiating the specified action. The table shown in Figure 30 of the '447 patent appears to be used for determining the response to send to a user based on a score determined during an authentication process, such as the queries to

the user shown in Figures 34-36. Col. 15, lines 57-67. The Examiner has failed to show how the '447 reference teaches presenting a list of allowable actions as set forth in claims 13, 14, 36 and 37.

With regard to claims 52 and 73, the claims are directed toward presenting a role to the user for selection based on a determined level of trust. The Examiner points to no teaching for offering a role to a user in the reference relied upon. The '447 patent does not appear to contain any such teaching. The Examiner has failed to show how the '447 reference teaches offering a role to a user as set forth in claims 52 and 73.

The Examiner has failed to show how the reference relied upon teaches each and every element of the invention as set forth in the claims. The reference relied upon does not appear to teach the invention as claimed. The claims contain statutory subject matter. Therefore, the application is considered in good and proper form for allowance, and the Examiner is respectfully requested to pass this application to issue. Failing that, the Examiner is requested to withdraw the final rejection and enter the present response in order to clarify the issues for appeal. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,



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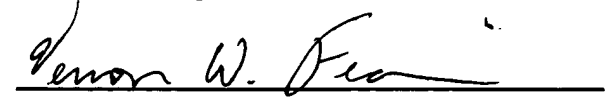
Date: December 27, 2005

CERTIFICATE OF MAILING

I hereby certify that this **RESPONSE TO FINAL OFFICE ACTION OF NOVEMBER 3, 2005** (along with any documents referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

Date: December 27, 2005



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